

## **REMARKS**

### **1. Summary of the Office Action**

In the Office Action mailed January 25, 2008, (i) the Examiner rejected claims 1-3, 5, 7, 8, 11-15, 17-24, 38, 42-45, 48-51, and 55-67 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0083439 (hereinafter “Eldering”) in view of U.S. Patent No. 5,948,061 (hereinafter “Merriman”), and (ii) the Examiner rejected claims 31, 39, and 52 under 35 U.S.C. § 103(a) as being unpatentable over Eldering in view of Merriman and U.S. Patent No. 7,017,173 (hereinafter “Armstrong”).

### **2. Amendments and Pending Claims**

Applicant has amended claims 1, 2, 5, 7, 11, 20-23, 38, 40, 41, 49, 51, 53, 54, and 61, cancelled claims 24, 32-33, 42-48, 57-58, and 64-65, and added new claims 68-79. Claims 1-3, 5, 7, 8, 11-15, 17-23, 31, 38, 39, 49-52, 55, 56, 59-63, and 66-79 are pending, of which claims 1, 38, 49, and 51 are independent. Claims 40, 41, 53, and 54 were previously withdrawn.

Support for the amendment to claims 1, 38, 49, and 51 is located in the specification, for example, at (i) page 8, 3<sup>rd</sup> paragraph, (ii) page 12, 3<sup>rd</sup> and 4<sup>th</sup> paragraphs, (iii) page 13, 2<sup>nd</sup> and 3<sup>rd</sup> paragraphs, (iv) page 14, 1<sup>st</sup> and 2<sup>nd</sup> paragraphs, (v) page 15, (vi) page 23, claim 24, and (vii) Figures 5, 7a, 7b, and 9a.

Support for new claim 68 is located in the specification, for example, at page 14, 2<sup>nd</sup> paragraph, and Figure 7b. Support for new claim 69 is located in the specification, for example, at page 13, 4<sup>th</sup> paragraph, page 19, 2<sup>nd</sup> full paragraph, and Figure 6. Support for new claim 70 is located in the specification, for example, at page 15, 2<sup>nd</sup> paragraph

and Figure 5. Support for new claims 71 and 72 is located in the specification, for example, at page 12, 3<sup>rd</sup> paragraph. Support for new claim 73 is located in the specification, for example, at (i) page 6, 1<sup>st</sup> full paragraph, (ii) page 8, 3<sup>rd</sup> paragraph, (iii) page 11, 3<sup>rd</sup> full paragraph, and (iv) Figures 1a, 2, and 3. Support for new claims 74-77 is located in the specification, for example, at page 13, 2<sup>nd</sup> and 3<sup>rd</sup> paragraphs, page 14, 5<sup>th</sup> paragraph, page 15, 3<sup>rd</sup> full paragraph, and page 16, 1<sup>st</sup> and 2<sup>nd</sup> paragraphs. Support for new claims 78 and 79 is located in the specification, for example, at page 6, 1<sup>st</sup> full paragraph, and page 15, 1<sup>st</sup> full paragraph.

### **3. Response to Claim Rejections**

#### **a. Claims 24, 42-45, 48, 57, 58, 64, and 65**

The Examiner rejected claims 24, 42-45, 48, 57, 58, 64, and 65 under 35 U.S.C. § 103 (a) as being unpatentable over Eldering in view of Merriman. Applicant has cancelled claims 24, 42-45, 48, 57, 58, 64, and 65. Applicant submits that the rejection of claims 24, 42-45, 48, 57, 58, 64, and 65 is moot, and thus, Applicant respectfully requests that the Examiner withdraw the rejection of claims 24, 42-45, 48, 57, 58, 64, and 65.

#### **b. Claims 1-3, 5, 7, 8, 11-15, 17-23, 31, 38, 39, 49-52, 55, 56, 59-63, 66, and 67**

The Examiner rejected independent claims 1, 38, 49, and 51 under 35 U.S.C. § 103 (a) as being unpatentable over Eldering in view of Merriman. Claims 1, 38, 49, and 51, as amended, patentably distinguish over Eldering and Merriman.

First, the combination of Eldering and Merriman does not reasonably lead to (i) *receiving a plurality of ad control files*, wherein each ad control file is associated with a

respective ad of the plurality of ads, wherein each ad control file identifies one or more parameters, and wherein one or more of the identified parameters is a trigger parameter, and (ii) *maintaining a trigger table that includes at least one trigger parameter added to the trigger table from the ad control files*, wherein each trigger parameter of the trigger table is associated with one or more ads of the plurality of ads, as recited in amended claims 1, 38, 49, and 51. For purposes of this paper, these elements will be referred to hereinafter as “the first elements of claims 1, 38, 49, and 51.”

With respect to the first elements of claims 1, 38, 49, and 51, the primary reference Eldering, at best, discloses (i) configuring an ad processing unit to detect any change in one or more *viewing parameters associated with a subscriber system (e.g., a TV, a VCR, or a personal video recorder (PVR))*, (ii) the viewing parameters may include, but are not limited to, the channel selections made by a current viewer, the identity of the current viewer, the type of program being watched by the current viewer, and the size of the next avail (opening) in the current programming channel, and (iii) based on detecting changes in the viewing parameters, the ad processing unit may modify an ad insertion schedule. (See, e.g., Eldering, paragraphs 13, 30, and 32). The viewing parameters disclosed by Eldering do not amount to the claimed “trigger parameters,” at a minimum, because Eldering merely discloses that the viewing parameters are *associated with a subscriber system*, such as a TV, a VCR, or a PVR, whereas each of the claimed “trigger parameters” is *associated with one or more ads*.

Additionally, with respect to the first elements of claims 1, 38, 49, and 51, the secondary reference Merriman, at best, discloses: (i) an ad server process that stores a plurality of advertisements, and (ii) a database that stores each advertisement along with a

table of targeting profile criteria for the advertisement and other data regarding the advertisement. (See, e.g., Merriman, col. 4, lines 28-29, and col. 5, lines 64-67). As illustrated in Figure 3B of Merriman, the targeting profile criteria for each advertisement and/or the other data regarding the advertisement includes an AD ID, a start date, an end date, “total viewed” data, standard industry codes (SICs), a target number, “prior clicked on” data, and “pages ads seen on” data.

Assuming *arguendo* that at the time of Applicant’s invention, a person of ordinary skill in the art would have combined the teachings of Eldering and Merriman, the combination would, at best, disclose an ad processing unit and/or a subscriber system that includes an ad server process that stores a plurality of advertisements, ***detects any change in one or more viewing parameters associated with a subscriber system (e.g., a TV, VCR, or PVR)*** and modifies an ad insertion schedule based on detected changes in the viewing parameters, and a database that stores each advertisement along with a table of targeting profile criteria for the advertisement and other data regarding the advertisement. However, the combination of Eldering and Merriman would not reasonably lead to receiving a plurality of ad control files, and maintaining a trigger table that includes at least one trigger parameter ***added to the trigger table from the ad control files***, wherein ***each trigger parameter of the trigger table is associated with one or more ads of the plurality of ads***, as recited in amended claims 1, 38, 49, and 51.

Even assuming *arguendo* that the targeting profile criteria disclosed by the combination of Eldering and Merriman amount to the claimed “plurality of ad control files,” wherein each ad control file is associated with a respective ad of the plurality of ads, wherein each ad control file identifies one or more parameters, and wherein one or

more of the identified parameters is a trigger parameter, the combination of Eldering and Merriman does not reasonably lead to maintaining a trigger table that includes at least one trigger parameter added to the trigger table from the ad control files (i.e., the targeting profile criteria, according to the assumption), at a minimum, because Eldering and Merriman do not teach or suggest a trigger table nor adding any parameters from the targeting profile criteria (e.g., the AD ID, the start date, the end date, the “total viewed” data, the standard industry codes (SICs), the target number, the “prior clicked on” data, or the “pages ads seen on” data) to a trigger table.

Second, the combination of Eldering and Merriman does not reasonably lead to updating a parameter, *checking the trigger table to determine if the updated parameter is a trigger parameter for any ad of the plurality of ads*, and if so, *re-evaluating the placement value of each ad of the plurality of ads, and thereafter re-evaluating the order of the plurality of ads* to determine a next ad to be displayed, as recited in amended claims 1, 38, 49, and 51. (Emphasis added). For purposes of this paper, these elements will be referred to hereinafter as “the second elements of claims 1, 38, 49, and 51.”

With respect to the second elements of claims 1, 38, 49, and 51, the combination of Eldering and Merriman, at best, discloses: (i) configuring an ad processing unit to detect any change in one or more *viewing parameters associated with a subscriber system (e.g., a TV, a VCR, or a PVR)*, (ii) based on detecting changes in the viewing parameters, the ad processing unit modifies an ad insertion schedule, (iii) storing a plurality of advertisements at an ad server process, (iv) at a database, storing each advertisement along with a table of targeting profile criteria for the advertisement and other data regarding the advertisement, (v) from advertisements for which a user matches

the criteria and for which the user has seen the advertisement less than a threshold number of times, using a satisfaction index formula to select a particular advertisement to transmit back to the user, and (vi) upon selecting the advertisement, transmitting the selected advertisement to the user's browser over the Internet. (See, e.g., Eldering, paragraphs 30 and 32, and Merriman, col. 4, lines 28-29, col. 5, lines 64-67, and col. 6, lines 12-58).

However, even assuming *arguendo* that a given viewing parameter of the changed viewing parameters disclosed by the combination of Eldering and Merriman amount to the claimed "updated parameter," the combination of Eldering and Merriman does not reasonably lead to checking a trigger table to determine if the given viewing parameter (i.e., the updated parameter, according to the assumption) is a trigger parameter that is associated with one or more ads of a plurality of ads. Thus, even assuming *arguendo* that the combination of Eldering and Merriman's disclosure of using a satisfaction index formula to select a particular advertisement to transmit back to a user amounts to re-evaluating a placement value of each ad of the plurality of ads and thereafter re-evaluating an order of the plurality of ads to determine a next ad to be displayed, which Applicant does not concede, the combination of Eldering and Merriman does not reasonably lead to checking the trigger table to determine if the updated parameter is a trigger parameter for any ad of the plurality of ads, and if so, re-evaluating the placement value of each ad of the plurality of ads, and thereafter re-evaluating the order of the plurality of ads to determine a next ad to be displayed, as recited in claims 1, 38, 49, and 51.

Because Eldering and Merriman fail to reasonably lead to the invention recited in claims 1, 38, 49, and 51, Applicant submits that claims 1, 38, 49, and 51 are allowable. Further, without conceding the assertions made by the Examiner regarding dependent claims 2, 3, 5, 7, 8, 11-15, 17-23, 31, 39, 50, 52, 55, 56, 59-63, 66, and 67, Applicant submits that dependent claims 2, 3, 5, 7, 8, 11-15, 17-23, 31, 39, 50, 52, 55, 56, 59-63, 66, and 67 are allowable for at least the reason that they depend from one of allowable claims 1, 38, 49, and 51.

#### **4. New Claims**

Applicant has added new dependent claims 68-79. Applicant submits that dependent claims 68-79 are allowable for at least the reason that they depend from one of allowable claims 1, 38, 49, and 51.

#### **5. Conclusion**

Applicant believes that all of the pending claims have been addressed in this response. However, failure to address a specific rejection or assertion made by the Examiner does not signify that Applicant agrees with or concedes that rejection or assertion.

For the foregoing reasons, Applicant submits that claims 1-3, 5, 7, 8, 11-15, 17-23, 31, 38, 39, 49-52, 55, 56, 59-63, and 66-79 are in condition for allowance. Therefore, Applicant respectfully requests favorable reconsideration and allowance of all of the claims.

Respectfully submitted,

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